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09/945,467	09/04/2001	Harold F. Hynes		3259

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EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/945,467

Applicant(s)

HYNES, HAROLD F.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003 and 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 October 2003 has been entered.
2. This communication is in response to the Request for Continued Examination filed 12 November 2003 and amendment filed on 14 October 2003. Claims 17, 19, 21, and 29 have been amended. Claim 30 has been cancelled. Claims 1-29 remain pending.

Specification

3. The amendment filed 14 October 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:
 - a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

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b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc. The added material which is not supported by the original disclosure is as follows:

- ""Purchase Menu", secured on the originator's monitor" and "an assigned Purchase" key" as disclosed in claim 29, lines 2-3
- "with 75% or more of the data being provided by the purchasing department" on lines 8-10.

In particular, Applicant does not point to, nor was the Examiner able to find, any support for this newly added language within the specification as originally filed on 4 September 2001. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 4 September 2001.

5. The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

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6. The disclosure is objected to for the same reasons given in the prior Office Action (paper number 5, section 3, page 5) because of the following informalities: drawings may not be included in the specification. When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures and to the different parts by use of reference letters or numerals (preferably the latter). Appropriate correction is required.

Claim Objections

7. Claim 21 is objected to because of the following informalities: in line 5 claim ends with the word “and” and does not end with a period. Examiner is disregarding the word “and” at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Newly amended claim 29 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Dependent claim 29 recites limitations that are new matter, as discussed above, and is therefore rejected.

10. The rejection of claims 17-28, 30 under 35 U.S.C. 112, first paragraph, for containing new matter is hereby withdrawn due to the amendment filed 14 October 2003.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Newly amended claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Newly amended claim 19 recites the limitations "the dot" and "the circle" and "the order" on lines 4-5.

There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 17, 20, 24, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha, U.S. Patent Number 5, 870, 717 in view of Thomson et al, U.S. Patent Number 5, 121, 945, and Josephson, U.S. Patent Number 4, 974, 878 for substantially the same reasons given in the previous Office Action (paper number 12). Further reasons appear hereinbelow.

(A) The amendments to claim 17 appear to have been made merely to correct minor typographical or grammatical errors and to correct the language reciting limitations that contain new matter. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As per newly amended claim 17, Wiecha teaches an Electronic Commerce System for procuring goods/services by a number of users within an organization, from a number of vendors (Weicha; Figure 6, Figure 7, column 3, lines 54-61), consisting of

a document traveling electronically between participants of the system (Weicha; column 2, lines 12-19, column 7, lines 64-65, column 8, lines 8-21, column 9, lines 46-52), and

an electronic purchaser's system to introduce each One Page document to the system of serving these purchasing functions, progressively moving the document to the participants, following each step or tracking to recognize actions completed, verifications completed, actions

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needed, and sending or forwarding the document to the next action location, and a follow up or tracking system (Weicha; column 7, lines 9-16, 40-45, column 12, lines 39-67, column 13, line 26 to column 14, line 2);

a worksheet selected by the purchase originator when securing and preparing the document, to disclose justification of the purchase, possible supporting data, and in the case of contract orders, information on contract dates, purchases to date and past performance (Weicha; Figure 7, Item 132, column 4, lines 52-54, column 6, lines 29-34, column 7, lines 9-16, column 10, lines 4-11, 23-26); and

use of a plurality of terminals, work stations, servers, Intranet and Internet programs operating with "off the shelf" software systems chosen from selections current at the time of installing the One Page System, necessary to operate the One Page System (Weicha; see at least Figure 4, Figure 6, Figure 7, Abstract, column 1, line 57 to column 2, line 37).

Wiecha fails to explicitly disclose

a one page electronic purchasing document which collectively replaces individual paper and electronic purchase requisitions, purchase orders and vendors: acknowledgements, shipping notices, invoices, and statements; and successively serves their identical functions, and

a purchaser's payment system activated by the operation of the One Page document, arranging payment to the vendor's bank, without individual participation within the purchaser's organization; a system that is coupled with a time schedule for each action.

Thomson teaches

a one page electronic purchasing document or single, integrated multi-functional document, which collectively replaces individual paper and electronic purchase requisitions,

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purchase orders and vendors: acknowledgements, shipping notices, invoices, and statements; and successively serves their identical functions (Thomson; see at least Abstract, column 2, lines 56-67, column 4, line 63 to column 5, line 4, column 16, line 65 to column 17, line 25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Electronic Commerce System of Wiecha to include a one page electronic purchasing document or single, integrated multi-functional document, which collectively replaces individual paper and electronic purchase requisitions, purchase orders and vendors: acknowledgements, shipping notices, invoices, and statements; and successively serves their identical functions, as taught by Thomson, with the motivation of reducing the time, the labor, the documents processed, the correction procedures needed to resolve errors, and the resultant expenses of document processing, and provide the consumer and financial institution with an unquestionable high level of acceptance and widespread use as well as significant economic gains (Thomson; column 2, lines 56-67).

Josephson teaches

a purchaser's payment system activated by the operation of the One Page document, arranging payment to the vendor's bank, without individual participation within the purchaser's organization (Josephson; see at least Abstract, column 5, lines 44-56, column 6, lines 29-45, 50-58, column 7, lines 61-65, column 16, lines 10-27); and a system that is coupled with a time schedule for each action (Josephson; column 6, line 66 to column 7, line 5, column 16, lines 24-28)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collective teachings of Wiecha and Thomson to include a purchaser's

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payment system activated by the operation of the One Page document, arranging payment to the vendor's bank, without individual participation within the purchaser's organization and a system that is coupled with a time schedule for each action, as taught by Josephson, with the motivation of eliminating the requirement for redundant, labor intensive processes, eliminating the requirement of the remittance processing function to organize, compare, handle, control and process separate documents while providing a complete audit trail and accountability at each processing level and also providing the flexibility to tailor the payment document to specific customized requirements (Josephson; Abstract, column 5, lines 35-43).

(B) As per claims 20, 24, 27-28, Wiecha, Thomson, Josephson and Ivanov teach an Electronic Commerce System as analyzed and discussed above in the claim 17 rejection above wherein the vendor acknowledges the order by inserting the vendor's invoice number in the One Page document, and Emailing it back to the purchaser's System, thereby avoiding any problems of the vendor not having a compatible electronic signature system (Weicha; column 7, lines 10-16, column 9, lines 60-63, column 10, lines 38-44, 50-52, column 12, lines 48-51, column 13, lines 9-11, column 15, lines 12-23) and

wherein the vendor attaches a bar code label to the outside of the order shipped, displaying the purchase document and invoice numbers, which will be used by the receiver to identify the One Page document for verification of receipt, thereby eliminating the usual shipping document (Thomson; Figure 1a, Figure 1b, column 15, line 30 to column 16, line 10); and

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wherein the vendor is permitted to put a "stop" on the preparation and processing of their documents replaced by the system, but continuing the use of the invoice number as identified with the One Page document, thereby saving substantial work and cost for the vendor (Josephson; see at least Figure 8, column 6, lines 50-58, column 12, lines 10-58); and

wherein a Purchase Worksheet provides a choice for either fixed assets or expenses applicable to larger purchases which justify the purchase, and provides information on use of items replaced, depreciation reserves, writeoffs, other purchases required, etc., with this worksheet made an addition to the One Page document for internal use and fitted into a program for "other purchase actions", such as accounting and taxes, along with its use for auditing the One Page System (Weicha; Figure 7, Item 132, column 4, lines 52-54, column 6, lines 29-34, column 7, lines 9-16, column 10, lines 4-11, 23-26).

15. Claims 18-19, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha, U.S. Patent Number 5, 870, 717 in view of Thomson et al, U.S. Patent Number 5, 121, 945, and Josephson, U.S. Patent Number 4, 974, 878 as applied to claim 17 above, and further in view of Johnson et al, U.S. Patent Number 6, 023, 683 for substantially the same reasons given in the previous Office Action (paper number 12). Further reasons appear hereinbelow.

(A) As per newly added claim 18, Wiecha, Thomson, and Josephson teach an Electronic Commerce System as analyzed and discussed above in the claim 17 rejection.

Wiecha, Thomson, and Josephson fail to explicitly disclose a system wherein a One Page document used to perform the functions of the system, is selected from a choice of three forms of

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purchasing, by size and type of purchase, and provides for the needs of the different participants, as prepared by the originator.

Johnson teaches a system wherein a One Page document used to perform the functions of the system, is selected from a choice of three forms of purchasing, by size and type of purchase, and provides for the needs of the different participants, as prepared by the originator (Johnson ; column 18, lines 55-67, column 15, lines 45-49)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collective teachings of Wiecha, Thomson, and Josephson to include wherein a One Page document used to perform the functions of the system, is selected from a choice of three forms of purchasing, by size and type of purchase, and provides for the needs of the different participants, as prepared by the originator, as taught by Johnson, with the motivation of providing an electronic sourcing method and system capable of creating an order list that provides a user with the capability of searching a database containing data (including product/vendor identification, and other product information) relating to items available from at least two vendors and the capability of transferring the product information (for example, a product number and a vendor identifier, such as vendor name and/or vendor number) or order list for desired items to a requisition/purchasing system for inclusion in a requisition generated by the system (Johnson; column 2, line 46 to column 3, line 2).

(B) Claim 19 has been amended to include the recitation of "with the finder of the necessary changes first deleting the dot in the circle on the order which directed the action to him, and also the dot in the circle which preceded his own circle" in lines 3-6.

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As per newly amended claim 19, Wiecha, Thomson, Josephson, and Johnson teach a system as analyzed and discussed above

wherein during the progression of the One Page document through its functional steps, any changes found necessary will require the action of the originator, with the finder of the necessary changes first deleting the dot in the circle on the order which directed the action to him, and also the dot in the circle which preceded his own circle, thereby producing a form or requisition, "Action Change Request", to secure explanations why changes are necessary, then, to be returned back into the system, in reverse sequence, for necessary action by the order originator (Johnson; see at least Figure 3, Item 110, Figure 3, column 2, line 46 to column 3, line 24, column 11, lines 30-61, column 13, line 1 to column 14, line 45, column 15, lines 9-21, column 15, line 60 to column 16, line 32).

(C) As per claim 26, Wiecha, Thomson, Josephson and Johnson teach a system as analyzed and discussed above

wherein a section is contained in the One Page document for the originator to enter the amounts and accounts to be charged for the items purchased, which is entered into the system to be held in suspense until the item is received as acknowledged, and charged to that account(s) with an accounts payable entry (Johnson; column 6, line 39 to column 7, line 12, column 7, lines 51-60).

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16. Newly amended claim 21 and previously amended claims 22-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha, U.S. Patent Number 5, 870, 717 in view of Thomson et al, U.S. Patent Number 5, 121, 945, and Josephson, U.S. Patent Number 4, 974, 878, as applied to claim 17 above, and further in view of Walker et al, U.S. Patent Number 5, 794, 207 for substantially the same reasons given in the previous Office Action (paper number 12). Further reasons appear hereinbelow.

(A) Claim 21 has been amended to recite

- “those employees engaged in purchasing” in line 2; and
- “which, by using the One Page document, easily permits verification of their actions completed, by others, including auditors checking for prescribed conformance in the purchasing system” in lines 3-5.

As per newly amended claim 21, Wiecha, Thomson, and Josephson teach an Electronic Commerce System as analyzed and discussed above in the claim 17 rejection.

Wiecha, Thomson, and Josephson fail to explicitly disclose a system wherein electronic signatures are required of those employees engaged in purchasing to acknowledge their actions completed which, by using the One Page document, easily permits verification of their actions completed, by others, including auditors checking for prescribed conformance in the purchasing system.

Walker teaches a system wherein electronic signatures are required (Walker; see at least Figure 10, column 8, line 56 to column 9, line 51, column 17, lines 7-9, column 19, lines 10-12, 29-53)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collective teachings of Wiecha, Thomson, and Josephson to include the use of electronic signatures for acknowledgment and verification, as taught by Walker, with the motivation of providing a system of bilateral buyer-driven electronic commerce that offers the capability for individual buyers to issue authenticatable messages which contain the terms of a purchase offer, allowing a seller who meets the terms of the purchase offer to bind the buyer to accept the seller's fulfillment of that offer and be able to collect funds immediately upon his acceptance of the buyer's terms as set forth in the purchase offer, providing a system in which the identity of the buyer is authenticated along with the integrity of the buyer's purchase offer and in which the identity of the seller is authenticated in order to determine the seller's capacity to satisfy the conditions of the purchase offer (Walker; column 7, line 9 to column 8, line 20).

(B) As per claims 22-23, 25, Wiecha, Thomson, Josephson, and Walker teach an Electronic Commerce System as analyzed and discussed above in the claim 17 rejection

wherein the total amount of the One Page document, including taxes, handling charges, etc. will be established at the outset, when the document is prepared, thereby having the correct amount for authorization approval, vendor acceptance, and payment advice to the paying bank, without the usual need for a vendor's invoice, before arranging payment (Walker; see at least column 8, lines 41-55, column 10, line 40 to column 11, line 2, column 19, lines 29-45); and

wherein the purchaser is required to prearrange terms of payment with the vendor, which is scheduled into the system, thereby permitting the purchaser to adjust payments to fit the purchaser's cash flow needs, and without this, the vendor would have no basis for being paid

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(Walker; see at least column 8, lines 41-55, column 10, line 40 to column 11, line 2, column 19, lines 29-45); and

wherein a member of the purchaser's receiving department uses a hand held computer or PDA or scanner and the vendor's bar code reference, to reveal the items listed on the One Page document, clicking in the space provided to confirm receipt of each item, and when the order is completely checked, the member's electronic signature will be accepted by the system, ready for the originator's signature of acceptance, thereby using the original One Page form to avoid any mistakes in identification of the order content (Josephson; see at least column 5, line 59 to column 6, line 10, column 8, lines 60-67), (Walker; see at least column 17, lines 7-26, column 18, lines 33-37).

17. Newly amended claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiecha, U.S. Patent Number 5, 870, 717 in view of Thomson et al, U.S. Patent Number 5, 121, 945, Josephson, U.S. Patent Number 4, 974, 878, as applied to claim 17 above, and further in view of Barnes et al, U.S. Patent Number 5, 970, 475 for substantially the same reasons given in the previous Office Action (paper number 12). Further reasons appear hereinbelow.

(A) Claim 29 has been amended to recite

- “available for selection, such as” in line 4, and
- “with 75 % or more of the data being provided by the purchasing department” in lines 8-10.

As per newly amended claim 29, Wiecha, Thomson, and Josephson teach an Electronic Commerce System as analyzed and discussed above in the claim 17 rejection, including data being provided by the purchasing department (Johnson; column 14, lines 46-55, column 17, line 55 to column 18, line 32).

Wiecha, Thomson, and Josephson fail to explicitly disclose a system wherein the initiation of an order requires use of a form "Purchase Menu", secured on the originator's monitor by pressing an assigned "Purchase" key on the keyboard, which lists a choice of information and action links available for selection, such as company purchasing policies, procedures, worksheet, order form, vendor and product sources, orders outstanding, previous orders and accounts to be charged, thereby accessing the necessary information to complete the purchase worksheet when required, and the data to be inserted in the One Page form.

Barnes teaches a system wherein the initiation of an order requires use of a form "Purchase Menu", secured on the originator's monitor by pressing the purchase option (reads on an assigned "Purchase" key) on the keyboard, which lists a choice of information and action links, including company purchasing policies, procedures, worksheet, order form, vendor and product sources, orders outstanding, previous orders, accounts to be charged, etc., thereby accessing the necessary information to complete the purchase worksheet when required, and the data to be inserted in the One Page form (Barnes; Figure 10, Item 131f, Figure 11, Item 134, Figure 12, column 5, lines 1-4, column 22, lines 36-45, column 25, lines 26-63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collective teachings of Wiecha, Thomson, and Josephson to include wherein the initiation of an order requires use of a form "Purchase Menu", secured on the

originator's monitor by pressing an assigned "Purchase" key on the keyboard, which lists a choice of information and action links available for selection, such as company purchasing policies, procedures, worksheet, order form, vendor and product sources, orders outstanding, previous orders and accounts to be charged, thereby accessing the necessary information to complete the purchase worksheet when required, and the data to be inserted in the One Page form, as taught by Barnes, with the motivation of providing an electronic procurement system which is easy to implement and to use, providing a method of initiating and consummating sales transactions of goods and/or services by buyers and suppliers, providing secure electronic purchasing transactions between a buyer and supplier without third-party intervention, and providing an electronic commerce procurement system which permits automated payments by the buyer organization's bank to the supplier or supplier's bank after goods/services have been ordered and delivered to the buyer. (Barnes; column 5, lines 5-42).

Response to Arguments

18. Applicant's arguments filed 14 October 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 14 October 2003.

(A) At pages 7-9 of the 14 October 2003 response Applicant explains amendments to the claims that overcome objections and rejections detailed in the prior Office Action (paper number 12).

(B) At page 10 of the 14 October 2003 response, Applicant argues that the limitations ““Purchase Menu”, secured on the originator's monitor” and “an assigned “Purchase” key on the keyboard” as recited in lines 2-3 of claim 29 are supported by page 6, line 15 and page 8, line 17 of the specification. Examiner respectfully disagrees, and notes that the mere one-time mention of “use is made of a Purchase Resources program available by using computer windows” in the specification (page 6, line 15) does not imply the existence of a ““Purchase Menu”, secured on the originator's monitor” and “an assigned “Purchase” key on the keyboard.” As such, Examiner respectfully maintains the objection to the specification and rejection under 35 U.S.C. 112, first paragraph, as detailed in the prior Office Action (paper number 12), as containing subject matter which was not described in the specification.

(C) At page 11 of the 14 October 2003 response, Applicant argues that the limitations “with 75 % or more of the data being provided by the purchasing department” as recited in lines 8-10 of claim 29 are supported by page 8, lines 20-24 of the specification. Examiner respectfully disagrees, and notes that these lines discuss “working with the purchasing department to produce a PD [purchase document] to send the vendor” and “[t]he purchasing department would add [the] (PW) [Purchase Worksheet]...number ...to the PD number ...[that] would accompany the PD as part of the database...files” (page 8, lines 20-24) but that these lines do not recite or imply the recited limitation “with 75 % or more of the data being provided by the purchasing department.” As such, Examiner respectfully maintains the objection to the specification and rejection under 35 U.S.C. 112, first paragraph, as detailed above in this Office Action, as containing subject matter which was not described in the specification.

(D) At pages 12-17 of the 14 October 2003 response, Applicant responds to the rejection in the in 5 May 2003 Office Action (paper number 12) of the newly added claims in the 6 February 2003 amendment. Applicant apparently argues that a *prima facie* case of obviousness has not been established.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 12) have been expressly articulated. Note, for example, the motivations explicitly stated at lines 13-17 of page 8 of the previous Office Action (paper number 12) (i.e., "with the motivation of reducing the time, as well as significant economic gains") and at lines 8-13 of page 9 of the previous Office Action (paper number 12) (i.e., "the motivation of eliminating the requirement for redundant ...") and at lines 6-15 of page 14 of the previous Office Action (i.e., "the motivation providing a system of bilateral ...").

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(E) At pages 12-17 of the 14 October 2003 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In addition, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In particular, Examiner notes that the limitations of Electronic Commerce System for procuring goods/services by a number of users within an organization, from a number of vendors, comprising a one page electronic purchasing document which collectively replaces individual paper and electronic purchase requisitions, purchase orders and vendors acknowledgements, shipping notices, invoices, and statements and successively serves their

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identical functions, traveling electronically between participants of the system, and an electronic purchaser's system to introduce each one page document to the system of serving these purchasing functions, progressively moving the document to the participants, following each step to recognize actions completed, verifications completed, actions needed, and sending the document to the next action location, coupled with a time schedule for each action, and a follow up system; a one page worksheet selected by the purchase originator when securing and preparing the one page document, to disclose justification of the purchase, possible supporting data, and in the case of contract orders, information on contract dates, purchases to date and past performance; a purchaser's payment system activated by the operation of the one page document, arranging payment to the vendor's bank, without individual participation within the purchaser's organization, is taught by the combination of cited references.

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

(F) At pages 18-19 of the 14 October 2003 response, Applicant contends that the applied references fail to teach a one page electronic purchasing document or single, integrated multi-functional document, which collectively replaces individual paper and electronic purchase

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requisitions, purchase orders and vendors: acknowledgements, shipping notices, invoices, and statements; and successively serves their identical functions. In response, all of the limitations which Applicant disputes are missing in the applied references, including the features newly added in the 14 October 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Wiecha, Thomson, Josephson, Johnson, Walker and Barnes, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 5 and 12), and incorporated herein. In particular, Examiner notes that Wiecha, Thomson, Josephson, Johnson, Walker and Barnes single, integrated multi-functional document, which collectively replace individual paper and electronic documents. Note, for example, that Thomson teaches, “[t]hese documents form an integrated document ... to effect a variety of multi-function transactions... requirement for ...labor intensive processes are eliminated...creating a complete audit trail and accountability”(Thomson; Abstract) and Thomson also teaches “incorporate the essential elements ...into a single document thereby reducing the time, the labor, the documents processed, the correction procedures needed to resolve errors, and the resultant expenses of such processing...significant automatic gains.. automated system” (Thomson; column2, lines 56-66). Thomson also teaches “uses data extracted from multiple sources...to produce the integrated document containing variable contents...” (Thomson; column 17, lines 1-8) (reads on single, integrated multi-functional document, which collectively replaces individual paper and electronic purchase requisitions, purchase orders and

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vendors: acknowledgements, shipping notices, invoices, and statements; and successively serves their identical functions).

(G) At pages 18-19 of the 14 October 2003 response, Applicant contends that the Examiner is doing piecemeal analysis of the claims and that there is no motivation to combine the references. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to

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one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has

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been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

In response to the assertion that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to the argument that if the proposed combination was made, the overall result would not be Applicant's invention, the Examiner respectfully submits that the courts have broadly held that it is sufficient if the prior art clearly suggests doing what Applicants have done, although an underlying explanation of exactly why this should be done is not taught as suggested by the cited references. *In re Gershon*, 152 USPQ 602 (CCPA 1967). Moreover, the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR

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1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section" Applicant has failed to **specifically point out how the language of the claims patentably distinguishes them from the applied references**. Simply stated, what distinctions, if any, are there between Applicant's One Page purchasing system and the corresponding elements of the Wiecha, Thomson, Josephson, Johnson, Walker and Barnes references? Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a customizable bi-directional electronic data interchange system which includes an electronic forms application that accepts and verifies information entered into the fields of a graphical user interface and then translates and transmits data to a destination location (5,758,126).

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20. Any response to this action should be mailed to:

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or faxed to: **(703) 305-7687.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
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After Final communications should be labeled "Box AF."


Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

21. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The
examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The
examiner can also be reached on alternate Fridays.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature
or relating to the status of this application or proceeding should be directed to the Receptionist
whose telephone number is (703) 308-1113.


Natalie A. Pass

January 26, 2004


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600